

REMARKS

Claims 1, 2 and 7 to 11 are in the application. Claims 3-6 have been cancelled. Claims 2 and 7 have been amended to better clarify the invention. Claims 8-11 have been added. Support for the newly added claims lies in the originally filed claims and in the working examples. No new matter is believed added.

Rejection under 35 USC §112

Claim 3 is rejected under 35 USC §112, 2nd paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regards as the invention.

Claims 3-6 are rejected under 35 USC §112, 1st paragraph as being enabling for the treatment of various kinds of arthritis, but is nonenabling for the remaining diseases (as listed on page 3 of the Office Action).

Applicants respectfully traverse both of these rejections.

The specification provides a lengthy discussion on the role of the p38 kinase and inhibition of the pro-inflammatory cytokines in this pathway. Applicants have submitted a number of references which clearly teach the linkage of inhibition of p38 to the treatment of a number of diseases in which this pathway is a factor.

The Examiner comments that it is unclear what diseases are intended by the language “method of treating a CSBP/RK/p38 kinase mediated disease”. This is functional claim language which the USPTO has granted a significant number of patents to in this field. As many diseases may have this pathway as part of their disease progression, Applicants believe that this is in fact a reasonable way to claim use of these compounds.

The Examiner presents the Wands factors in the Office Action (under the 112, 1st para rejection), but disregards the overall fact that no showing of actual treatment of a disease is necessary for a claim related thereto. The Examiner is incorrect that the specification does not “test any of the claimed compounds”. (see page 5, 1st ¶ Office Action). The specification does

provide a wide range of available assays (pages 39-lines 20-38 – page 46, lines 1-6. Specifically the CSBP kinase assay (page 41, lines 21-38-page 42, lines 1-8) describes the testing of compounds of Examples 1-3 which are shown to be active in that binding assay. Also, in an alternative binding assay, see pages 45, lines 11-36- page 46, lines 1 6 which indicates that the aforementioned compounds plus additional compounds have been tested and shown to be active in this assay. Therefore, *in vitro* data showing inhibition of the p38 kinase. *In vivo* animal data is not necessary to for establishing the breadth of the claim language.

However, in order to advance prosecution on the merits, Applicants have cancelled claims Claim 3-6, and will continue prosecution of the deleted or cancelled subject matter in a later filed application.

In view of these remarks and amendments, reconsideration and withdrawal of the rejection to the claims under 35 USC §112 is respectfully requested.

Rejection under Obvious Double Patenting

Claims 1-4 are rejected on the grounds of the nonstatutory obviousness-type double patenting over Claims 1-14, 17, 18, 20, 26-28, 31, 34, 36, 38 and 40-44 of US Patent No. 7,314,881.

Applicants submit herewith a terminal disclaimer over the claims of US Patent No. 7,314,881.

Claim 7 is rejected on the grounds of the nonstatutory obviousness-type double patenting over Claims 1-4, 8, 11 13-18 and 37-39 of US Patent No. 7,314,934.

Applicants submit herewith a terminal disclaimer over the claims of US Patent No. 7,314,881.

In view of these submissions, withdrawal of the rejection to the claims under the grounds of nonstatutory obviousness-type double patenting is respectfully requested.

Conclusion

Should the Examiner have any questions or wish to discuss any aspect of this case, the Examiner is encouraged to call the undersigned at the number below. If any additional fees or charges are required by this paper the Commissioner is hereby authorized to charge Deposit account 19-2570 accordingly.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Dara L. Dinner".

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